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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,310	04/20/2004	Takashi Ikeda	393032045000	5659
25224 7590 10/25/2007 MORRISON & FOERSTER, LLP 555 WEST FIFTH STREET SUITE 3500 LOS ANGELES, CA 90013-1024			EXAMINER MURDOUGH, JOSHUA A	
			ART UNIT 4132	PAPER NUMBER
			MAIL DATE 10/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/829,310

Applicant(s)

IKEDA ET'AL.

Examiner

Joshua Murdough

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>4/20/2004, 5/15/2006</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The “sections” of claims 1-15 do not positively recite the physical components; therefore, given the broadest reasonable interpretation, the sections could be purely software. Claims 16-18 expressly recite software. Software is per se non-statutory due to the lack of tangibility. If the medium they reside on or the physical components included in the apparatus were claimed, there would no longer be an issue with the lack of tangibility.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Boykin (2001/0042048).

As to claim 1, Boykin shows:

A music-content using apparatus comprising:

an acquisition section that acquires original music content; (Figure 2, 202)

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a replicated content generation section that generates new music content on the basis of replication of the original music content acquired via said acquisition section; (Paragraph 0035) and

an additional information generation section that, when said replicated content generation section generates the new music content, generates additional information including information indicating that the generated new music content is based on replication and replication source information identifying a replicated-from source of the replicated content (Paragraph 0035),

wherein the additional information generated by said additional information generation section is added to the new music content generated by said replicated content generation section (Figure 2, 210).

As to claim 2, Boykin further shows:

said replicated content generation section replicates the original music content and generates, as the new music content, the replicated music content that comprises a replication of at least some of substance data of the original music content.

(Paragraph 0035 & Figure 2; the replicated music content is the original)

As to claim 3, Boykin further shows:

the new music content comprises a replication of all of the substance data of the original music content (Paragraph 0035; the replicated music content is the original).

As to claim 4, Boykin further shows:

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said replicated content generation section replicates the original music content and performs editing to change at least some of substance data of the replicated music content, to thereby generate, as the new music content, the replicated music content that includes at least the substance data changed by the editing.

(Paragraph 0045; The music is edited to only allow a low quality version of the original to be played unless the key is present)

As to claim 5, Boykin further shows:

the new music content includes, as its substance data, only the substance data changed by the editing. (Paragraph 0045; The new music content is an edited reproduction at a low quality, which is available separately.)

As to claim 6, Boykin further shows:

the new music content does not include the substance data not changed by the editing, and a storage location of the new music content is indicated by the replication source information included in the additional information added to the new music content. (Paragraphs 0024-0026; The DBMS, 114, accesses the edited or the original version depending on the access privileges. As the original is encrypted and the copy is not, they necessarily separate.)

As to claim 7, Boykin further shows:

the new music content generated by said replicated content generation section includes a management data region and substance data region, and the additional information generated by said additional information generation section is stored in the management data region. (Figure 2, 210; The information is written into the

file. If it was not written to a separate section of the file, the player would attempt to play it as music and most likely produce sounds that are not appealing to the ear or cause the file to be rendered unplayable.)

As to claim 8, Boykin further shows:

a search section (Figure 2, 108) that, when the new music content is to be used, searches for the acquired original music content on the basis of the replication source information included in the additional information (Paragraphs 0020-0021); and

a use section that permits use of the new music content only when the original music content has been successfully found by said search section (Paragraphs 0020-0021).

As to claim 9, Boykin further shows:

a storage medium that stores music content (Figure 1, 116); and an encryption section that encrypts (Figure 1, 120), with medium information specific to said storage medium, music content to be stored in said storage medium and then storing the encrypted music content in said storage medium (Paragraph 0025).

As to claim 10, Boykin shows:

A music-content using apparatus comprising: an acquisition section that acquires music content including additional information added thereto (Figure 2, 202), the additional information including information indicating that the music content is based on replication and replication source information identifying a replicated-from source of the music content; (Paragraph 0035)

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a search section that searches for original music content on the basis of the source information included in the additional information added to the music content acquired via said acquisition section; (Paragraph 0021; The originating user, or source, is found, searched for, and credited with distributing the content.) and a use section that permits use of the acquired music content only when the original music content has been successfully found by said search section (Paragraph 0020; The user identifier in the file is from the previous user not the new one.).

As to claim 11, Boykin further shows:

the music content acquired via said acquisition section includes a management data region and substance data region, and the additional information is stored in the management data region. (Figure 2, 210; The information is written into the file. If it was not written to a separate section of the file, the player would attempt to play it as music and most likely produce sounds that are not appealing to the ear or cause the file to be rendered unplayable.)

As to claim 12, Boykin further shows:

in the management data region, there are included substance data of the acquired music content that comprise a replication of at least some of substance data of the original music content. (Paragraph 0035 & Figure 2; the replicated music content is the original)

As to claim 13, Boykin further shows:

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in the management data region, there are included substance data of the acquired music content obtained by changing at least some of substance data of the original music content. (Paragraph 0035; the replicated music content is the original)

As to claim 14, Boykin further shows:

when use of the acquired music content is being permitted (Paragraph 0020)

The following section of the claim fails to further limit because it is optional:

“if the at least some of substance data of the original music content are not included in the substance data region of the acquired music content, said use section acquires the at least some of substance data from the original music content found by said search section.”

This interpretation is supported by: In re Johnston, 77 USPQ2d 1788 (CA FC 2006),

Wherein it was said, “As matter of linguistic precision, optional claim elements do not narrow claim, since they can always be omitted; in present case, elements of dependent claim directed to large diameter spirally formed pipe, which recite ‘further including that said wall may be smooth, corrugated, or profiled with increased dimensional proportions as pipe size is increased,’ do not narrow scope of claim compared to claims lacking those elements, since elements are stated in permissive form ‘may.’” Furthermore MPEP §2106 II C says, “Language that suggest or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation.”

As to claim 15, Boykin further shows:

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a storage medium that stores music content (Figure 1, 116); and
an encryption section that encrypts (Figure 1, 120), with medium information specific to said storage medium, music content to be stored in said storage medium and then storing the encrypted music content in said storage medium (Paragraph 0025).

As to claim 16, Boykin shows:

A program containing a group of instructions for causing a computer to perform a music-content using method, said music-content using method comprising:
an acquisition step of acquiring original music content (Figure 2, 202);
a replicated content generation step of generating new music content on the basis of replication of the original music content acquired via said acquisition step (Paragraph 0035); and
an additional information generation step of, when said replicated content generation step generates the new music content, generating additional information including information indicating that the generated new music content is based on replication and replication source information identifying a replicated-from source of the replicated content, (Paragraph 0035)
wherein the additional information generated by said additional information generation step is added to the new music content generated by said replicated content generation step (Figure 2, 210).

As to claim 17, Boykin further shows:

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a search step of, when the new music content is to be used, searching for the original music content (Figure 2, 108) on the basis of the replication source information included in the additional information (Paragraphs 0020-0021); and
a step of permitting use of the new music content only when the original music content has been successfully found by said search step (Paragraphs 0020-0021).

As to claim 18, Boykin shows:

A program containing a group of instructions for causing a computer to perform a music-content using method, said music-content using method comprising:
an acquisition step of acquiring music content including additional information added thereto (Figure 2, 202),
the additional information including information indicating that the music content is based on replication and replication source information identifying a replicated-from source of the music content (Paragraph 0035);
a search step of searching for original music content of the acquired music content on the basis of the replication source information included in the additional information added to the music content acquired via said acquisition step (Paragraphs 0020-0021); and
a step of permitting use of the acquired music content only when the original music content has been successfully found by said search step (Paragraphs 0020-0021).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua Murdough whose telephone number is (571) 270-3270. The examiner can normally be reached on Monday - Thursday, 7:00 a.m. - 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Khoi Tran can be reached on (571) 272-6919. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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